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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/532,361

04/20/2005

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CR49U-US

1513

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Avon Place
Suffern, NY 10901

07/20/2009

EXAMINER

VENKAT, JYOTHSNA A

ART UNIT

PAPER NUMBER

1619

MAIL DATE

DELIVERY MODE

07/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/532,361	Applicant(s) MCNAMARA ET AL.	
	Examiner JYOTHSNA A. VENKAT	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date | 6) <input type="checkbox"/> Other: _____ |

4/20/2005;3/11/2009;5/14/2009;5/18/2009

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DETAILED ACTION

Receipt is acknowledged of election filed on 5/14/09 and IDS filed on 4/20/05; 3/11/09; 5/14/09; 5/14/09 and 5/18/09. Claims 1-59 are pending in the application. Upon further review of applicants' remarks, restriction requirement dated 3/29/09 is hereby withdrawn.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-59 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification at page 16 teaches solubilizing system employing a triblock copolymer surfactant, an ammonium cocoyl isothionate and polyvinyl alcohol and teaches using this solubilizing system in mascara formulations and at page 18 teaches that when this composition is spread on hair fibers, such as eyelashes foam is obtained. Specification does not describe A post-application expanding cosmetically acceptable composition for application to hair fibers of the scalp, eyebrows or eyelashes comprising at least one surfactant, a solvent for the surfactant, a volatile agent in an amount effective to cause the surfactant and solvent to interact and produce a foam on the hair fibers and thereby produce an expanded composition, and a film-forming agent, the film-forming agent being present in an amount effective to

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form a film after application of the composition to the hair fibers and, when the film sets,, to fix at least a portion of the expanded composition, the volatile agent being solubilized in the composition, and the volatile agent further being dispersed throughout the composition in nanometer sized droplets or generated in situ on the hair fibers or immediately prior to application to the hair fibers, whereby the composition is storable in a non-pressurized container (claim 1)

or

A post-application expanding cosmetically acceptable composition for application to hair fibers of the scalp, eyebrows or eyelashes comprising at least one surfactant, a solvent for the surfactant, a volatile agent *in an amount effective to swell the composition after application to the hair fibers,* and a film-forming agent, the film-forming agent being present in an amount effective to form a film and, *when the film sets, to fix at least a portion of the swelled composition in an expanded state, the volatile agent being solubilized in the composition, and the volatile agent further being dispersed throughout the composition in nanometer sized droplets or generated in situ on the hair fibers or immediately prior to application to the hair fibers,* whereby the composition is storable in a non-pressurized container (claim 2)

or

A method for *imparting a volumizing effect to hair of the scalp, eyebrows or eyelashes comprising the step of contacting the hair with the composition of Claim 2 for a time sufficient to obtain said effect (claim 34)*

or

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A post-expanding composition comprising a film-forming agent, a surfactant, a solvent for the surfactant, and a volatile agent, wherein the film-forming agent is present in an amount effective to form a film that entraps at least a portion of foam formed by interaction of the volatile agent and the surfactant after the composition is applied to a hair fiber, the volatile agent being solubilized in the composition, and the volatile agent further being dispersed throughout the composition in nanometer sized droplets or generated in situ on the hair fiber or immediately prior to application to the hair fibers whereby the composition is storable in a non-pressurized container(claim 35)

or

A mascara composition, the improvement comprising including in the composition (i) at least one surfactant, (ii) a solvent for the surfactant, (iii) a volatile agent that will interact with the surfactant and the solvent to cause the mascara composition to expand after the composition is applied to eyelashes, (iv) a film-forming agent in an amount effective to form a film that entraps at least a portion of the expanded composition and when set maintains at least a portion of the composition in an expanded state, and (v) the volatile agent being solubilized in the composition, and the volatile agent further being dispersed throughout the composition in nanometer sized droplets or generated in situ on the eyelashes or immediately prior to application to the hair fibers, whereby the composition imparts a volumizing effect to the eyelashes upon which it is applied and wherein the composition is storable in a non-pressurized container (claim 43)

or

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A post-application expanding cosmetically acceptable composition for application to hair fibers of the scalp, eyebrows or eyelashes comprising at least one surfactant, a solvent for the surfactant, a volatile agent *in an amount effective to cause the surfactant and the solvent to produce a foam on the hair fibers which increases radial configuration of the composition on the hair fibers, and a film-forming agent in an amount effective to fix the increased radial configuration of at least a portion of the composition on the hair fibers,* the volatile agent being solubilized in the composition, and the volatile agent further being dispersed throughout the composition in nanometer sized droplets or generated in situ on the hair fibers or immediately prior to application to the hair fibers, whereby the composition is storable in a non-pressurized container (claim 45).

The specification fails to describe the claimed method of voluminizing eyelashes (emphasis added) using the composition of claim 2 let alone composition for voluminizing hair of the scalp or eyebrows.

None of the examples teach the claimed property claimed in claims 1, 2, 34, 35 and 43-44.

The specification does not describe using the composition of claim 2 to be washed out with water or the same composition being water resistant. *How can the same composition be rinsed with water and at the same time being resistant to rinsing with water?*

None of the disclosed compositions are taught as actually having different property claimed in claims 1, 2, 35 and 43-44 and using the composition of claim 2 for imparting voluminizing effect to hair of the scalp, eyebrows or eyelashes. The specification provides insufficient written description to support the genus encompassed by the claims.

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Vas-Cath Inc. v. Mahurkar, 19 USPQ2d 1111, makes clear that "applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the 'written description' inquiry, whatever is now claimed." (See page 1117.) The specification does not "clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed." (See Vas-Cath at page 1116.)

The skilled artisan cannot envision which compositions described in examples would possess the property described in claims 1, 2, 35 and 43-44 . Adequate written description requires more than a mere statement that it is part of the invention and reference to a potential method for isolating it. The composition itself is required. See *Fiefs v. Revel*, 25 USPQ2d 1601, 1606 (CAFC 1993) and *Amgen Inc. V. Chugai Pharmaceutical Co. Ltd.*, 18 USPQ2d 1016. In *Fiddes v. Baird*, 30 USPQ2d 1481, 1483, claims directed to mammalian FGF's were found unpatentable due to lack of written description for the broad class. The specification provided only the bovine sequence. Finally, *University of California v. Eli Lilly and Co.*, 43 USPQ2d 1398, 1404, 1405 held that: "...To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (1997); *In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) (" [T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as

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words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention."

Lockwood , 107 F.3d at 1572, 41 USPQ2d at 1966.

The specification teaches compositions **but does not teach any of the compositions** actually possessing the required property claimed in claims 1-2, 35 and 43-44 (emphasis added) and thus what is disclosed is not representative of the genus because the genus is highly variant. Applicant is reminded that Vas-Cath makes clear that the written description provision of 35 USC § 112 is severable from its enablement provision. (See page 1115.).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18-19, 22 and 41-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 18-19 lacks clarity since the same composition is water rinseable as well as resistant to water rinsing. How can this be accomplished?

Recitation of trademarks in claim 22 is indefinite and it lacks clarity.

What is the amount colorant that sufficient to mask the color in claim 41?

Claim 42 lacks antecedent basis since claim 41 recites that "composition contains the colorant in an amount sufficient to mask the color", where as claim 42 recites that the "colorant is pigment and is present in amount sufficient to impart to the eyelash color". Claims are ambiguous.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-50 of copending Application No. 10/502,061. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the applications are claiming post-application expanding compositions using surfactant, solvent, volatile agent and film forming agent and the only difference being co-pending application does not claim the composition is storable in non-pressurized container. It is obvious to one skilled in the art to use the compositions of co-pending applications and store in non-pressurized container so that foam is obtained.

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising, the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66

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USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); *Genentech, Inc. v. Chiron Corp.*, 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.). Using the transitional phrase "consisting of" excludes any element, step, or ingredient not ~specified in the claim. In re Gray, 53 F.2d 520, 11 USPQ 255 (CCPA 1931); *Ex parte Davis*, 80 USPQ 448, 450 (Bd. App. 1948).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 3-5, 7, 9-13, 1824, 27-28, and 31-38 of copending Application No. 10/331,069. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the applications are claiming post – foaming compositions using surfactant, solvent, volatile agent and film forming agent and the only difference being co-pending application does not claim the composition is storable in non-pressurized container and the co-pending application is claiming the composition in the form of gel.

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open- ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-33 and 35-59 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-55 of copending Application No. 10/532,362. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the applications are claiming post –application expanding compositions using surfactant, solvent, volatile agent and film forming agent.

It is obvious to use the post-application expanding compositions for the claimed method, which is improving the skin appearance claimed in co-pending application.

The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open- ended and does not exclude additional, unrecited elements or method steps. See, e.g., *Mars Inc. v. H.J. Heinz Co.*, 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."). *Invitrogen Corp. v. BiocrestMfg., L.P.*, 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JYOTHSNA A VENKAT /
Primary Examiner, Art Unit 1619